RECORDS AND BRIEFS

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IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,

Petitioner,

v.

SIMON SHIAO TAM,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF CERTAIN MEMBERS OF CONGRESS AS AMICI CURIAE IN SUPPORT OF NEITHER PARTY

JOHN T. JOHNSON
FISH & RICHARDSON P.C.
601 Lexington Avenue
52nd Floor
New York, NY 10022
(212) 765-5070
jjohnson@fr.com

JOHN DRAGSETH
Counsel of Record
FISH & RICHARDSON P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
(612) 335-5070
dragseth@fr.com

Counsel for Amici

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INTEREST OF THE AMICI CURIAE[1]

Amici are certain Members of the U.S. House of Representatives and one Member of the U.S. Senate, as identified below.

U.S. House of Representatives:

- Rep. Hakeem Jeffries (NY-08)
- Rep. Karen Bass (CA-37)
- Rep. Joyce Beatty (OH-03)
- Rep. G.K. Butterfield (NC-01)
- Rep. Judy Chu (CA-27)
- Rep. David Cicilline (RI-01)
- Rep. Yvette Clarke (NY-09)
- Rep. Theodore Deutch (FL-21)
- Rep. Tulsi Gabbard (HI-02)
- Rep. Colleen Hanabusa (HI-01)
- Rep. Michael Honda (CA-17)
- Rep. Sheila Jackson Lee (TX-18)
- Rep. Henry C. "Hank" Johnson Jr. (GA-04)
- Rep. Barbara Lee (CA-13)
- Rep. John Lewis (GA-05)
- Rep. Ted Lieu (CA-33)
- Rep. Grace Meng (NY-06)

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[1] Letters consenting to the filing of this brief are on file with the Clerk. No counsel for a party authored this brief in whole or in part, and no person, other than amici or their counsel, made any monetary contribution to the preparation or submission of this brief.

- Rep. Gwen Moore (WI-04)
- Del. Eleanor Holmes Norton (DC-at large)
- Rep. Scott Peters (CA-52)
- Rep. Cedric Richmond (LA-02)
- Rep. Terri Sewell (AL-07)
- Rep. Mark Takano (CA-41)
- Rep. Frederica S. Wilson (FL-24)
- Rep. Doris Matsui (CA-06)

U.S. Senate:

- Sen. Mazie K. Hirono (HI)

Amici represent diverse communities in the United States Congress and file this brief on behalf of themselves and their constituents, who would be negatively impacted if the government was required to sanction disparaging trademarks.

Amici believe that Section 2(a) is Constitutional because it does not interfere with free expression even as it refuses federal-trademark protection to a great variety of racist, sexist, and homophobic words. As Members of Congress, we have a strong interest in seeing that the government protects legitimate First Amendment rights while ensuring the efficient flow of commerce that underpins trademark law. We also have a strong interest because of the odious and lasting discriminatory impact that disparaging and hateful terms have on American society and in particularly on communities of color.

Amici do not support either party even though we argue for the Constitutionality of Section 2(a) because Amici are neutral regarding the ultimate outcome of

the case, and whether the USPTO properly or improperly denied registration.[2]

SUMMARY OF THE ARGUMENT

This case is about whether the government must put its stamp of approval on particular types of words—it is not about restricting speech. Disparaging, racist, sexist, and homophobic words do little to forward any goals of the First Amendment, and do even less as identifiers of source. Rather, they distract from the goals of both First Amendment law and trademark law—they create resistance in consumers without communicating helpful information about products or services. While the First Amendment properly protects all viewpoints that are expressed in a forum for speech, trademark registration is not a forum for the free exchange of ideas: it is, instead, government approval of source-identifying marks for commercial goods and services. And the presence or absence of a circle-R symbol or legal procedural rights does not allow a successful applicant to use the mark in expressing himself, or to prevent an unsuccessful applicant from expressing himself. Accordingly, consistent with the First Amendment, Congress may limit trademark registration to marks that are efficient source-identifiers. Disparaging marks are not: they distract consumers and improperly arouse passions without designating source in a meaningful manner. Section 2(a) of the Lanham Act is constitutional.

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[2] In accordance with Supreme Court Rule 37.3, this brief is submitted within 7 days after the time allowed for filing the petitioner's brief because this amicus brief is in support of neither party.

ARGUMENT

I. Disparaging Trademarks Encourage Discriminatory Behavior

Language is powerful. It shapes our attitudes and informs our actions. Racist, sexist, misogynist, and homophobic slurs in everyday commerce send the message that discriminatory behavior is acceptable. *See Mishawaka Rubber & Woolen Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) ("The protection of trademarks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them.").[3] Hate is the natural creator of disparagement, and its natural result is the unnatural treatment of disparaged people.

We know personally the acidic effects of disparaging terms from our own lives, from the experiences that drove us to serve, and from the stories we hear from our constituents who battle disparagement and discrimination daily. Disparaging terms used with goods and services communicate to consumers prejudicial messages that negatively impact buying decisions. Rather than cementing in the mind of a listener a connection to a source of goods or services (as a trademark is supposed to do), racial epithets and other disparaging terms enflame hateful passions: "Whether a restaurant named, 'SPICS NOT WELCOME' would actually serve a Hispanic patron is

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[3] We recognize that Mr. Tam is an Asian- American whose goals in obtaining the mark here appear honorable. But we also recognize that trademark law cares about the impression that the mark's use may leave on the public, and not the applicant's identity or intent. *Cf. Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 203 (5th Cir. 1998).

hardly the point. The mere use of the demeaning mark in commerce communicates a discriminatory intent as harmful as the fruit produced by the discriminatory conduct." *In re Tam*, 808 F.3d 1321, 1380 (Fed. Cir. 2015) (en banc) (Reyna, J., dissenting). The clarity that trademark law seeks to provide consumers becomes lost in the dissonance of the term's hate.

Moreover, because a trademark affords its owner the right to sue and seek damages, the presence of a disparaging mark imposes a chilling effect on the public. Trademark rights extend beyond repetition of the exact mark (that is, to any use that might cause a likelihood of confusion). The presence of that disparaging mark therefore imposes a particularly broad chilling effect on the very segment of the public that needs all the tools it can muster to respond to the hate that disparaging marks contain.

Disparaging trademarks also signal to the public that hateful conduct is acceptable—not merely against the targeted group of the trademark, but against other groups too. "The public acceptance of hateful language against one group suggests tolerance of other hateful language and treatment toward others groups." Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, *in* Diversity in Intellectual Property: Identities, Interests, and Intersections 105-29 (Irene Calboli & Srividhya Ragavan eds., 2015). While we may need to put up with and counter such terms in day-to-day debate, there is no need, and certainly no requirement, that the government place its seal of approval on them in the form of the circle-R.

And discriminatory conduct negatively disrupts commerce. Commerce works best when it is not

blocked by illogical hate and prejudice. Hateful, disparaging marks help create an economic embargo against the targeted group who cannot engage in the free market on equal terms. *See Katzenbach v. McClung*, 379 U.S. 294, 299 (1964) (commenting on "the burdens placed on interstate commerce by racial discriminations"); *see also Heart of Atlanta Motel, Inc. v. United States*, 379 U.S. 241, 252 (1964) (commenting on the "burdens that discrimination by race or color places upon interstate commerce"). Congress has properly and repeatedly fought discrimination in interstate commerce with tough antidiscrimination laws. *See, e.g.*, Civil Rights Act of 1964, Pub. L. No. 88-352, 78 Stat. 241; Pregnancy Discrimination Act of 1978, Pub. L. No. 95-555, 92 Stat. 2076; Americans with Disabilities Act of 1990, Pub. L. No. 101-336, 104 Stat. 327; Family and Medical Leave Act of 1993, Pub. L. No. 103-3, 107 Stat. 6.

The First Amendment should not be turned "into a free pass out of antidiscrimination laws." *Boy Scouts of Am. v. Dale*, 530 U.S. 640, 688 (2000) (Stevens, J., dissenting). If the Court facially strikes down Section 2(a), the USPTO will be powerless to prevent entities from registering offensive marks—indeed highly offensive ones.

For example, the USPTO has used Section 2(a) to refuse registration to the following marks:

- SOUTHERN WHITE KNIGHTS TO THE KU KLUX KLAN[4]
- PUSSY NIGGA BE COOL (P. N. B. C.)[5]
- S.N.I.T.C.H= SUCKA NIGGA INFORMING THE COPS HATING[6]
- BABY JAP[7]
- BFF BIG FUCKING FAGGOT[8]
- CUNT[9]
- FUDGEPACKERS[10]

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[4] U.S. Trademark App. No. 78/478,272 (filed Sept. 2, 2004).

[5] U.S. Trademark App. No. 85/952,753 (filed June 6, 2013).

[6] U.S. Trademark App. No. 85/379,668 (filed July 25, 2011).

[7] U.S. Trademark App. No. 78/665,332 (filed July 7, 2005).

[8] U.S. Trademark App. No. 77/722,463 (filed Apr. 25, 2009).

[9] U.S. Trademark App. No. 77/048,672 (filed Nov. 21, 2006)

[10] U.S. Trademark App. No. 78/681,877 (filed July 29, 2005)

The USPTO has also used Section 2(a) to refuse registration of the design mark "HADJI, PLEASE!" for firearm targets:[11]

If the Court holds Section 2(a) facially unconstitutional, entities may register these kinds of disparaging marks—and place next to the marks the circle-R that indicates government endorsement to the public. Free speech is not forwarded by the commodification of racist, sexist, homophobic words and marks.

Re-appropriation of the term here is certainly a laudable goal, but that goal will be harmed, not helped, by trademark registration. To change the way that the public understands a term takes time and broad-based work. That is best achieved if the public has full access to the term: to debate about it, to use it, and to condemn any improper and hateful use of it. And until the public properly understands the term as non-disparaging, it is best left open for public use rather than being subjected to limitation via registration. *Cf.* DYKES ON BIKES, Registration No.

[11] U.S. Trademark App. No. 77/424,420 (filed Mar. 18, 2008).

3,323,803 (allowing registration after applicant provided evidence that the term had been re-appropriated as a term of endearment and empowerment).

In short, disparaging terms are best left open for the public. They should not be reserved to a single private party, even if narrowed to a single good or service. The government's favorable association with such terms causes great harm, while doing little to enhance free expression.

II. Trademark Law Is for Trade Identification—Not a Forum for Exchanging Ideas

Congress defines a "trademark" as something "to identify and distinguish [an applicant's] goods." 15 U.S.C. § 1127. Trademark rights require both use of the mark in commercial activity and ability to indicate source to the public. *Id.* § 1051(a)(3)(C). Trademarks are not works of "original expression"—that is copyright. *Compare id.* § 1127, *with* 17 U.S.C. § 102. Any expressive function of a trademark is incidental: "[t]he Trademark Act is not an act to register words but to register trademarks." *In re Standard Oil Co.*, 275 F.2d 945, 947 (C.C.P.A. 1960).

Trademark registration is not a soapbox, a pulpit, a bullhorn, or a microphone. It is not a street, park, or sidewalk. *See United States v. Kokinda*, 497 U.S. 720 (1990). In this Court's vernacular, trademark registration is not a "forum." *See Int'l Soc'y for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672 (1992); Alan Brownstein, *The Nonforum as a First Amendment Category: Bringing Order Out of the Chaos of Free Speech Cases Involving School-Sponsored Activities*, 42 U.C. Davis L. Rev. 717, 784 (2009). Rather, the relevant "forum" here is any location in which com-

mercial speech may occur. But the term for which registration is sought can be used freely in that forum—indeed, Tam and his bandmates appear to be using SLANTS fully and freely. The refusal of registration itself does not constitute restriction of speech in a forum, and its practical result does not prevent such speech in any way. It simply means that the speech may not have a circle-R next to it, and that the speaker may not obtain extra litigation-related benefits that are unavailable to other speakers in the forum.

Moreover, a term when presented as a registered trademark bears the government's imprimatur: the circle-R. Government-stamped racist, sexist, and homophobic trademarks tell the public: "We approve." But the First Amendment permits the government to withhold its approval. A public-school newspaper may censor its students' articles on pregnancy and divorce. *Hazelwood Sch. Dist. v. Kuhlmeier*, 484 U.S. 260, 271 (1988) (permitting censorship of "expressive activities" that "the public might reasonably perceive to bear the imprimatur of the school"). So too then may Congress refuse to confer its circle-R on disparaging marks.

Further still, registered trademarks involve government speech and thus are within the government's discretion. This Court held in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), that a vehicle's license plate with a personally chosen background or design was government speech, *id.* at 2248. So too are registered trademarks. Like license plates, the USPTO "maintains direct control over the messages conveyed" with registered trademarks. *Id.* at 2249. Every registered trademark is issued by the USPTO, just as "every Texas license

plate is issued by the State." *Id.* at 2248. And registered trademarks serve the governmental purpose of source identification, just like "[e]ach Texas license plate . . . serv[es] the governmental purposes of vehicle registration and identification." *Id.*

Most importantly, the Court in *Walker* noted that "a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message. . . . [T]he individual prefers a license plate design to the purely private speech expressed through bumper stickers . . . because Texas's license plate designs convey government agreement with the message displayed." *Id.* at 2249. And so when a trademark applicant asks the government for its circle-R, any registered mark necessarily becomes government speech.

Tam's invocation of the First Amendment in this case is ironic. The First Amendment, in fact, has traditionally and properly been used to *narrow* trademark-holders' rights—not enlarge them. That is because the Court has recognized that assertion of registered marks *lessens* the ability of the general public to speak. For instance, artists have used the First Amendment as a defense when they have incorporated trademarks into their artistic work. *See, e.g.*, *Rogers v. Grimaldi*, 875 F.2d 994, 998 (9th Cir. 1989) ("[O]verextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values."). And the First Amendment protects unauthorized use of registered trademarks for parody. *E.g.*, *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996). The irony of this case only buttresses the point that trademarks are not subject to First Amendment protection.

Moreover, the First Amendment issue here is not a one-way street in an applicant's direction, but instead involves competing considerations by which protection of the general public's right to speak is paramount.

III. Offensive Trademarks Are Inherently Inefficient Source-Identifiers

Ineffective source-identifiers cannot be trademarked. Most notably, Congress has carved out "generic" and "merely descriptive" terms from trademark protection because they are bad source-identifiers. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-74 (1992) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976)). The word 'PAPER' cannot be a valid trademark for paper; consumers would have no idea where PAPER-brand paper comes from.

Disparaging marks too are poor trademarks, but for a very different reason: they distract consumers. Disparaging marks are so infused with non-source meaning that they cannot perform their source-identifying function. Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 Yale L.J. F. 178, 187-88 (2016) ("Slurs leave less room for trademark meanings than do the comparative neutral terms that trademark law traditionally favors."). A disparaging term immediately shifts consumers' focus away from the product and to the odious sentiment of the offensive term. No longer is a consumer contemplating which product to buy; rather, her response to seeing the disparaging term is personal, political, and emotional—not commercial.

The marketplace is best served by transactions that are based on rational decision-making and not on

racial slurs, disparaging comments, and insults. "Commerce does not benefit from political volatility, nor from insults, discrimination or bigotry." *Tam*, 808 F.3d at 1380.

CONCLUSION

For the reasons above, the Court should hold that Section 2(a) is not facially unconstitutional.

Respectfully submitted,

JOHN T. JOHNSON
FISH & RICHARDSON P.C.
601 Lexington Avenue
52nd Floor
New York, NY 10022
(212) 765-5070
jjohnson@fr.com

JOHN A. DRAGSETH
Counsel of Record
FISH & RICHARDSON P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
(612) 335-5070
dragseth@fr.com

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